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finger and said finger pad shield is attached to said enclosure.

Remarks

I.

In the Specification.

In accordance with Applicants' understanding of Examiner's objection to the drawing, Applicants have changed the paragraph starting on page 18 and extending to page 19, so the description of the overleaf 24 corresponds to the element shown as 24 in the drawings.

Accordingly, to Applicants' understanding of Examiner's objection, No change to the drawings are required as the drawings were correct and the error appearing in the specification has been corrected by this Amendment.

II.

In the Claims

Claim 33 is amended to correct an informality in the sequence of the paragraphs.

Claims 37 and 44 are amended to correct informalities noted by Examiner.

III.

The Standard Of Appellate Review For Patent Office Examination, Requires Examiner's Findings Be Supported By Substantial Evidence In the Record.

A. Examiner's rejection is made under the standard of substantial evidence, as set forth below, requiring a fact based conclusion based on substantial evidence. Dickenson v. Zurko 50 USPQ 2d 1930, 1936, and in which asks whether a reasonable mind might accept a particular evidentiary record as adequate to support a conclusion. Zurko, at 1935. See In re. Kotzab 217 F. 3d 1365 (Fed. Cir 2000) requiring the rejection be "based on particular findings," at 1370. See In re. Gartside 203 F.3d 1305 (Fed. Cir. 2000) requiring that a rejection be based on substantial evidence meaning "...such relevant evidence as a reasonable mind might accept as adequate to support a conclusion...." at 1312; and that a Patent Office decision, "must explicate its factual conclusions enabling... [the Court...] to verify readily whether those conclusions are indeed supported by 'substantial evidence'".

Examiner's grounds for rejection must be reversed when factual findings underlying Examiner's stated grounds

of rejection are not supported by concrete evidence in the record. In re. Zurko 258 F.3d 1379 (Fed. Cir) 2001, at 1386. The substantial evidence standard of review for a Patent Office rejection requires complete record of all of the facts and reasoning that were used or should have been used, in support of the arguments rejecting Appellants' claims and rebutting Appellants' arguments for patentability. The substantial evidence standard requires a finding of such relevant evidence as a reasonable mind might accept as adequate to support a conclusion. *Id.* at 1384. Basic knowledge or common sense, which is not based on any evidence in the record, lacks substantial evidence support. *Id.* at 1385.

Patent Office expertise is restricted to the support of conclusions "as to peripheral issues." However, with respect to core factual findings in a determination of patentability ... the [Examiner] cannot simply reach conclusions based on its own understanding or experience -or on [Examiner's] assessment of what would be basic knowledge or common sense. Rather, the [Examiner] must point to some concrete evidence in the record in support of.. [Examiner's] findings.

*Id* at 1385, 1386.

(Underlining added)

Required in support of a rejection is concrete evidence in the record. *Id.* at 1386.

B. Examiner's findings of fact, as shown herein by Applicants, are unsupported by substantial evidence in the record and fail to meet the examination standard of substantial evidence, as set forth herein.  
(hereinafter "the examination standard of substantial evidence")

#### IV.

#### The Rejection Under 35 USC 101 Does Not Meet The Examination Standard Of Substantial Evidence And Should Be Vacated

A. Examiner's grounds of rejection under 35 U.S.C. 101, are limited to a statement of 35 U.S.C. 101, the included case citations, and Examiner's statements, as follows.

- 1) In the instant case, the claims 33, 40, 43, 46-52,55, and 56, are directed to the natural phenomena of the forces that interact during the delivery of the ball.
- 2) In the instant case, the claims recite nothing more than the physical characteristics of the forces that act between a finger shield and the bowling ball while a player is bowling.
- 3) Here there exists no new form of finger protection and the forces that interact are naturally occurring in nature and not considered patentable.

B. Examiner has characterized the record claims without any consideration of the recited claims' elements or of the recited claims as respective whole claims inclusive of all recitations in each claim.

Examiner has selectively characterized the record claims without considering all words in the claims. See MPEP §2173.06 Prior Art Rejection of Claim Rejected as Indefinite, requiring all words in a claim must be considered in judging the patentability of a claim against the prior art. This requirement should be the rule applied in determining whether the record claims, as respective whole claims, meet the requirement of 35 USC 101 in properly reciting a manufacture or machine, invention.

C. Examiner's statements made in support of the rejection under 35 USC 101, are made without any support of record facts from the specification or the claims. Examiner has failed to support his statements with the recited claim elements taken in their respective whole claim recitations or as any separate recited claim elements, as taken from the record. Examiner has not considered any recited claim elements or the claims as a whole and it is impossible to know from Examiner's unsupported statements what recited claim elements or combination(s) of elements are unpatentable under 35 USC 101. Examiner has failed to explain the facts of this rejection or the logic of how the cited case law in combinations with any evidentiary record facts, support this rejection. Examiner has not shown how the O'Reilly v. Morse decision, limited to electrical and magnetic energy or how the facts of Funk Bros. Seed v. Kalo Inoculant Co. or Ex parte Grayson, decisions apply to the recited claimed invention.

Without any facts cited by Examiner, or application of the cited case law to the record facts of applicants' invention this rejection is a mere conclusion based on Examiners own understanding or experience or on Examiner's assessment of what would be basic knowledge or common sense. Examiner must point to some concrete evidence in the record and a rationale based on the facts and the law, to support of. Examiner's rejection, for this rejection to meet the examination standard of substantial evidence.

D. The U.S. Patent Office position on examining invention for compliance with 35 U.S.C. 101, is in the following guidelines.

The term 'manufacture' in § 101 means the production of articles for use from raw materials prepared by giving to these materials new forms, qualities, properties, or combinations whether by hand labor or by machinery.

In choosing such expansive terms as 'manufacture' and 'composition of matter,' modified by the

comprehensive 'any,' Congress plainly contemplated that the patent laws would be given wide scope.

A non-naturally occurring manufacture or composition of matter - a product of human ingenuity -having a distinctive name, character, [and] use is patentable subject matter.

The production of articles for use from raw materials prepared by giving to these materials new forms, qualities, properties, or combinations whether by hand labor or by machinery is a "manufacture" under 35 U.S.C. 101.

See MPEP §2105 Patentable Subject Matter - Living Subject Matter

E. The limited statements of Examiner, as set forth in this section, Paragraph A, above, do not have any evidentiary record support in the claims, are selectively chosen without any explanation for choosing these statement or why these statements logically support a rejection under 35 U.S.C. 101, are chosen by Examiner to represent the claimed invention, according to the Examiner' personal knowledge and do not apply to the invention as recited and described in the claims as respective whole claims. As such, these statements by Examiner, forming the sole basis of this rejection under 35 USC 101, are opinions or conclusions without any logical connection to the case law cited by Examiner, do not provide a rationale permitting Applicants to understand or rebut the rejection and fail to meet the examination standard of substantial evidence and must be vacated.

F. Applicants' invention, as recited in the whole claims, is a "manufacture," and a proper subject under 35 U.S.C. 101. Examiner's grounds of rejection (See Paragraph A, above), are conclusions, without reference to any record facts of the claims or explanation of why the claims, in their respective whole recitations, are not manufactures under 35 U.S.C. 101.

V.

Claims 37, 43, Rejected Under 35 USC 112, Have Been Amended

A. Applicants understanding of this rejection, based on the whole rejection, is Examiner meant to refer to claim 44 instead of 43, on page 3, line 6, of the Office Action, as claim 43 has a recitation similar to claim 37. Applicants have amended claims 37 and 43, in a manner believed to avoid this rejection.

B. Claims 37 and 43, reciting " wherein said fastener is an enclosure for a finger and said finger pad shield is attached to said enclosure. " refer to the antecedent "fastener" and further modify the fastener by the recitation of the "enclosure."

## VI.

Claims 40, 42 and 43 Meet All Requirements of 35 USC 112

A. Examiner's rejection is encompassed and restricted to his statements, for Claims 40 and 42, "In claims 40 and 42, the scope of 'maximum natural force' is indefinite. The term maximum relates to the intended use, by the strength of an individual, by the delivery of the ball and the weight of the ball. Such a variable is subjective,"

and for Claim 43,

"Claim 43 is inapt in that it fails to positively recite structure such that one can determine the metes and bounds of the claim. Currently is only narrative with functional recitations that fail to further limit the elements in the previously recited claims."

B. The guiding principles for 35 USC 112, 2<sup>nd</sup> Paragraph are stated in

1) MPEP §2173.01 Claim Terminology.

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. The release of the bowling ball and the "force" and the "maximum natural force," are not used contrary to accepted meaning in the art, are the terms chosen by Applicants to define their invention, and are not indefinite, as asserted by Examiner.

2) MPEP §2173.05(g) Functional Limitations

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

**3) MPEP §2173.05(b) Relative Terminology.**

The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

**4) MPEP §2173.06 Prior Art Rejection of Claim Rejected as Indefinite**

All words in a claim must be considered in judging the patentability of a claim against the prior art.

C. Examiner's rejection under 112, 2<sup>nd</sup> Paragraph fails the examination standard of substantial evidence and fails explain the facts or rationale of the rejection in a manner reasonably providing Applicants an opportunity to respond to this rejection.

Examiner has illogically, selectively and, without explanation, unreasonably parsed the record claims 40 and 42, without any explanation or rationale and relied on selected recited elements without reference to the claims as a respective whole claimed invention, has failed to explain his claim interpretation or why or how Examiner selected the parsed phrase "maximum natural force," to the exclusion of any other part of the recited claim and the basis and rationale in law, why this phrase, according to Examiner's conclusion, has no meaning in the claim taken as a whole, so it is not reasonably possible for Applicant to understand this rejection in a way that Applicant to rebut Examiner's opinion.

Examiner has stated the rejected claim 43 is "narrative with functional recitations that fail to further limit the elements in the previously recited claims," without stating how or why or otherwise explaining his interpretation of the claim as "narrative," or "with "functional limitations."

Examiner has failed to meet the examination standard of substantial evidence because Examiner has not shown by record facts from the recited record claims, taken as a whole description of the invention, why or how the "maximum natural force is subjective," or why or how "[t]he term maximum relates to intended use . . . [and] a variable [and] is subjective," or why or how "it positively fails to recite structure [and] the metes and bounds."

Examiner's limited statements are without record facts and fails explain the facts, basis in law or any other rationale of the rejection, in a manner reasonably providing Applicants an opportunity to respond to this rejection and this rejection fails the examination standard of substantial evidence.

D. Claims 40, 42 and 43, meet the requirements of 35 U.S.C. 112, 2<sup>nd</sup> Paragraph.

The force produced when a bowling ball is released is well known from the Shaffer patent 4,371,163 and to those skilled in the art. "Maximum natural force" is defined in the application with reference to a definite standard. Applicants recitation of "maximum natural force" is as accurate as the subject matter permits. circumscribed by the range of muscular skeletal development and the conventional weight of a bowling ball and the patent law does not require that all possible forces in that range corresponding to the full range of muscular skeletal development from children to fully developed largest size males, be listed in the claims and meet the requirements of 35 U.S.C. 112, 2<sup>nd</sup> Paragraph. See MPEP §2173.05(b) Relative Terminology.

See Rule 132 Declaration of Dr. W. Robert Addington, D.O., (submitted with this Amendment), stating, as a Board Certified Physician and expert in Rehabilitative Medicine, facts showing the "maximum natural force," as recited in the claims, is within a defined quantifiable range, that it is objectively measurable, and is not subjective.

E. Applicants have made a prima facie showing that claims 37 and 40 -45 meet the 2<sup>nd</sup> Paragraph of 35 USC 112, and it is Examiner's burden to rebut that prima facie showing by substantial evidence.

## VII.

### Claims 33, 34, 36, 38-43, And 45-58, Are Not Anticipated Under 102(b) By Fowble

A. MPEP §2131 Anticipation - Application of, requires that to anticipate a claim, the reference must teach every element of the claim. Examiner's rejection has failed to state record facts meeting or disclosing every element of the claims or explain his claim interpretation, in a manner giving Applicants a reasonable opportunity to dispute the rejection. Examiner's examination is deficient because it does not mention every element of the claims and does not show how the cited referent teaches every element of the claims and for that reason Examiner's rejection fails the examination standard of substantial evidence and must be vacated.

### B. The Limits To The Fowble Disclosure

Fowble is limited to a finger protector to protect the finger, without any disclosure, teaching, or showing, of protection for the finger pad. However, Fowble does describe the protector being of sufficient length to cover the entire finger. Page 1, lines 86 - 88. Fowble discloses the material may be made "more rigid," without disclosing any quantifiable or qualifiable standard or reference from which one skilled in the art may understand exactly "how" rigid" Fowble recommends or teaches the material may be except by telling us it should be rigid but not

rigid to resist bending. Page 1, lines 32 - 41. To the extent of Fowble's disclosure, there is nothing qualifying or quantifying the term "rigid," to show, teach, or describe, to one skilled in the art, what Fowble means by "rigid," or how "thick" or "rigid" to make the protector except it should be "thicker and more rigid than heretofore employed". Page 1, lines 33 - 36.

Accordingly, any reference to Fowble disclosing a "shield made of rigid material," is not supported by record based facts, fails the examination standard of substantial evidence, and is meaningless in the context of the record claims. Fowble's disclosure is limited to a protector designed to fit over the finger and made of a "thicker" or "more rigid" material that Fowble says was used previously but without disclosing what that previously used material is or was. Accordingly, Fowble does not disclose what kind of material is used, or what it does, except to prevent "galling" or "chafing" of the fingers. Page 1, lines 9 - 12.

Fowble is directed to prevent galling or chaffing of the fingers. Page 1, lines 9-12. The plain meaning of chaffing or galling, is to irritate or wear away by rubbing. Prevention of chaffing or galling does not require, or teach or describe a fixed relation of the protector of Fowble with the finger pad. The teaching and disclosure of Fowble is the protector may be positioned over the finger in any relation where the protector body is interposed between any part of the finger used to hold or grip the object and the object. The part of Fowble identified by Examiner as "strap 5," is not described except by reference to the drawing. Fowble describes the protector as having an open end to form an outlet for grit and sand liable to find its way between the protector and finger. Page 1, lines 67-74. This description of the protector open to allow accumulated grit or sand to leave through the "opening e to form an outlet, implies a loose fit where the Examiner identified "strap 5," does not provide any function except to prevent the loose fitting protector from falling away from the bottom of the finger. The foregoing is the limit of the Fowble disclosure of a "strap 5," and there is no disclosure beyond that limited disclosure of a strap or ring or any other means to hold the protector in a "fixed" or any other intended relationship with the finger, as recited in the claims, except a loose fit limited to the protection of the fingers from lateral forces along the surface of the protector which may gall or chafe the finger.

Fowble makes no disclosure of any "raised surface," or "limit means,; for limiting the depth of insertion of the finger pad shield into the finger hole of a bowling ball, as recited in the claims. The disclosure of Fowble of what Examiner identifies as "strap 5," is nothing more than a part of the protector, with its surface in line with the rounded exterior of the protector, and as described above is not "raised" relative to the claim as recited in combination with the "finger pad shield in claim 33, for example, as,

said finger pad shield includes a raised surface for contacting the surface of a bowling ball;

said raised surface is located proximate said open end and adapted to limit the depth of insertion of said finger pad shield into the finger hole of a bowling.

The Examiner asserted "strap 5," can be seen by inspection as not a "raised surface . . . adapted to limit the depth of insertion of said finger pad shield into the finger hole of a bowling ball," as recited in the claims.

In summary, Fowble's disclosure has no teaching or suggestion or disclosure of the structure of the material used in the disclosed protector.

While there is in Fowble, contact between the finger and the finger protector, Fowble only teaches a general area of possible contact or contact subject to change due to use. There is no disclosure in Fowble of "a contact area," or a "fastener," "to hold said contact area in a fixed relationship with a finger pad," as recited in the claims.

At best, Fowble discloses an undefined area over which the finger pad does not contact the protector in a fixed relationship with "a contact area," because the Fowble protector is disclosed as a loose fitting device, worn with enough clearance between the protector and the finger to allow sand and grit to accumulate and fall out, without intercession of the wearer, and disclosing a loose fit between the finger and the protector, permitting the finger to slide or move within the protector. There is no teaching or disclosure in Fowble of "a contact area," as the loose fit taught by Fowble, permitting the finger to move inside the protector, does not disclose and teaches away from "a contact area," and "said finger pad shield includes at least one fastener to hold said contact area in a fixed relationship with a finger pad; wherein a force produced in the release and lifting of the bowling ball, is spread over said contact area," as recited in representative claim 33.

The force of interest in Fowble and which the Fowble device is intended to prevent from galling or chaffing the wearer, as disclosed in Fowble, is a lateral force along the surface of the protector and no relation is shown, taught or described in Fowble of that force and any "contact area," whether explicit or implicit.

Fowble makes no disclosure of any "raised surface," or "limit means for limiting the depth of insertion of the finger pad shield into the finger hole of a bowling ball. The disclosure of Fowble of what Examiner identifies as "strap 5," is nothing more than a part of the protector, as described above.

C. The Fowble disclosure does not anticipate any record claims.

## 1) Claim 33 (Amended)

## a) Claim 33 (Amended) recites,

A bowler's finger pad shield for protecting a finger pad from the force produced when applying lift to a bowling ball, to rotate or spin the ball at its release, comprising:

- a) a finger pad shield with an open end adapted for insertion of a finger pad, said finger pad shield including a first surface and a second surface, extending from said open end; said first surface including a contact area located proximate said open end and positioned relative to said open end to receive a finger pad;
- b) said second surface is opposed to said first surface;
- c) said finger pad shield is adapted for insertion into the finger hole of a bowling ball, to place said second surface in contact with a bowling ball finger hole; and wherein
- d) said finger pad shield includes at least one fastener to hold said contact area in a fixed relationship with a finger pad; wherin a force produced in the release and lifting of the bowling ball, is spread over said contact area.

b) That Examiner has rejected the preamble is noted. The preamble reciting "A bowler's finger pad shield for protecting a finger pad from the force produced when applying lift to a bowling ball, to rotate or spin the ball at its release," sets forth the general purpose and environment for the use of the invention, as claimed in paragraphs a to e.

c) Examiner's rejection of claim 33 (aside from his statement regarding the preamble), is restricted to his statements,

- 1) Fowble shows a finger A, with an open end e, a first surface b and a second surface d;
- 2) the second surface d clearly opposes the first surface b and a fastener a;
- 3) the functional limitation pertaining to the intended use such as . . . paragraph a, "adapted for insertion of a finger pad; and paragraph d, "wherin a force produced in the release and lifting of the bowling ball, is spread over said contact area," do not distinguish over the art in an apparatus claim.

d) Examiner's rejection of claim 33 does not inform Applicants of the record facts of Fowble meeting each recited claim element or the rationale for excluding parts of the recited claim selected by Examiner and fails the examination standard of substantial evidence required to support a rejection under 35 USC 102.

e) Examiner's rejection of claim 33 fails to explain how, if at all, the Examiner alleged "functional"

limitations, were evaluated and considered as "not distinguish[ing] over the art in an apparatus claim." Examiner's statements are conclusions without record fact support and show Examiner did not consider the alleged "functional limitations, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. See MPEP §2173.05(g) Functional Limitations, Section VI, B, 2, above.

f) Examiner's ground of rejection is limited to a showing in Fowble of a finger pad shield with and open end, and a first and a second surface. It does not explain how all of the claim 33 recitations were evaluated or considered and did not apply Fowble to all of the recited claim 33 elements. Instead Examiner selectively choose to disregard the recited claim as a whole while selectively choosing alleged "functional" limitations without applying these limitations to the claim elements or the claim as a whole or explaining how these elements would have been considered to the whole claim by one of ordinary skill in the art of bowling.

Examiner's ground of rejection of claim 33 denies to Applicants an reasonable opportunity to rebut because it materially and significantly relies on Examiner's unsupported opinions about what is a "functional" limitation and unexplained conclusions that the alleged "functional" limitations, should be disregarded. The standard of substantial evidence for patent examinations requires record facts, and acceptable application of the law to support conclusions. All Examiner has given as reasons for disregarding alleged "functional" limitations as "not distinguish[ing] over the art in an apparatus claim and disregarding material and significant recited claim 33 elements, is his personal knowledge, which is unacceptable under the substantial evidence standard.

2) Claim 34 and 36

a) Claims 34 and 36, recite,

For claim 34, The bowler's finger pad shield of claim 33, wherein said at least one fastener is a strap, said at least one fastener is a strap..

For claim 36, The bowler's finger pad shield of claim 33, wherein said at least one fastener is a ring.

Claims 34 and 36 depend on independent claim 33 reciting,

a fastener to hold said contact area in a fixed relationship against a finger pad; wherein a force produced in the release and lifting of the bowling ball, is spread over said contact area.

b) The part "a" of Fowble has not been shown by Examiner as meeting the combined recitations of claim 33 and claim 34 and 36 respectively. Examiner's rejection stating "As to claims 34 and 36 . . . the fastener a is a strap considered a 'ring' and a 'glove' finger enclosure," is Examiner's opinion unsupported by record facts of

the recited claim elements under the requirements of 35 USC 102, that the reference must teach every element of the claim.

c) Examiner's rejection of claims 34 and 36, fails to meet the examination standard of substantial evidence and must be stricken.

3) Claims 38, 39, 45 and 53

a) Claims 38, 39, 45, and 53, recite,

For Claim 38,

The bowler's finger pad shield of claim 33, wherein said finger pad shield includes a raised surface for contacting the surface of a bowling ball; said raised surface is located proximate said open end and adapted to limit the depth of insertion of said finger pad shield into the finger hole of a bowling ball.

For Claim 39,

The bowler's finger pad shield means of Claim 38, wherein said raised surface extends in a direction away from said finger pad shield and said contact area.

For Claim 45,

The bowler's aid of claim 40, wherein said finger pad shield includes a raised surface extending away from said finger pad shield and said contact area and adapted to contact the surface of a bowling ball; and limit the depth of insertion of said finger pad shield into the finger hole of a bowling ball.

For Claim 53,

The bowler's aid of claim 46, including means for contacting the surface of a bowling ball to limit the depth of insertion into the finger hole of a bowling ball of said means for forming a contact area with a finger pad

b) Examiner's grounds of rejection is the statement "[a]s to claims 38, 39, 45 and 53, strap is capable as functioning as a 'limit means' and is considered a 'raised surface' when the limitations in the claims are given their broadest possible meaning," does not explain how the elements of Fowble cited by Examiner are the same as the recited claimed elements. Examiner has stated an opinion without showing by a rationale or evidence meets the recited claim limitations. Examiner is required to explain why or how Fowble teaches to one skilled in the art of bowling, element "a," is a "limit means," meeting the full recitation as claimed or a "raised surface," according to the full recitation as claimed. Examiner's statement is incomplete and an

opinion because it lacks that explanation of the record facts of Fowble in relation to the explicit claim recitations and, as an opinion or conclusion without facts or rationale, is without an argument and leaves the Applicants without a reasonable opportunity to rebut.

c) Examiner's rejection is incomplete and fails to meet the examination standard of substantial evidence and must be vacated.

4) Claims 49, 50, 52, and 56.

a) Examiner's statement that "Fowble is considered substantially 'more rigid material,' referring to Fowble col.1, line 35, and "[t]he shield of [Fowble] is inherently capable of resisting deformation from a force of a bowling ball during such intended use," does not meet the examination standard of substantial evidence and should be vacated.

b) Examiner has not shown by record evidence or by a rationale that the examiner cited disclosure of Fowble meets the claim recitations or that Fowble inherently capable of meeting those claim recitations.

c) Examiner relies on the doctrine of inherency. However, a proper showing of inherency requires Examiner must provide an rationale or evidence tending to show inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. See MPEP §2112 Requirements of Rejection Based on Inherency; Burden of Proof, in the following subparagraph d.

d) MPEP §2112 Requirements of Rejection Based on Inherency; Burden of Proof

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In relying upon the theory of inherency, the examiner must provide a basis in fact and/or

technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

e) Examiner's statement does not meet the requirement set forth in the MPEP for showing inherency, fails to meet the examination standard of substantial evidence and must be vacated.

5) Claims 42 and 51.

Examiner's statement 'the range within the limit of muscular skeletal development is the amount of force applied from 0 to where a person can no longer increase the force exerted on the object. Such is inherent in Fowble,' fails to meet the examination standard of substantial evidence for the reasons given above with respect to claims 49, 50, 52, and 56.

6) Claim 43, 46-56 and 58.

For claim 43, Examiner's statement "Fowble inherently is capable of spreading a force uniformly over a contact area; and for claims 46-56 and 58, Examiner's statement, "Fowble shows the function of placing a finger in the shield and having a force exerted between a user's finger and the shield to be the result of performing a task. These forces between the finger and the shield form 'a contact area', 'spread force produced' during the task (sic) . . . spread the force (sic) 'uniformly,' . . . resist deformation by the material's properties . . . and spreading over the widest area,' fails to meet the examination standard of substantial evidence for the reasons given above with respect to claims 49, 50, 52, and 56.

## VIII.

### Claims 35, 37, 44 and 57 Are Patentable In View Of Any Combination Of Fowble Or Pratt

#### A. The Limits Of the Pratt Disclosure

The disclosure of Pratt is limited to a glove with a finger grip insert. The inserts are resilient for use in picking up coins. .

Pratt teaches away from a rigid insert or any insert which protects the finger from a force against the finger pad, as the glove tips must be tactiley resilient so the user can feel coins. the force of the coins. See Pratt, col. 2, lines 1-26, and Pratt, generally.

**B. Limit of Examiners stated grounds of rejection**

Examiner's rejection is limited to the statements,

1) As to claims 35 and 58, adjustable straps in finger shields are and hand protectors are well known to secure same apparatus so one could achieve a desired fit; and

2) As to claims 37 and 44, Fowble fails to discuss any parts of a glove with respect to the use of his finger shield. Pratt shows combining finger inserts with gloves in order to combine the benefits of the insert with those of a gloved hand. To have included the insert of Fowble in a glove would have been obvious in order to protect the finger as well as the hand as a result of the benefits of the glove.

**C. Legal Concept of Prima Facie Obviousness, Manual of Patent Examining Procedure (MPEP) §2142****The Prior Art Must Suggest The Desirability Of The Claimed Invention.**

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *At-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

**MPEP §2143.01 Suggestion or Motivation To Modify the References****All Claim Limitations Must Be Taught or Suggested**

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d MPEP §2143.03

**All Claim Limitations Must Be Taught or Suggested****D. Claims 33-58 are not obvious over Fowble in view of Pratt**

a) To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

b) The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

See MPEP § 2144 - § 2144.09 for examples of acceptable reasoning supporting obviousness rejections.

d) There is no teaching or suggestion in Fowble or Pratt of combining the flexible inserts of Pratt into the protector of Fowble intended to be of vulcanized rubber to resist the lateral chaffing or galling forces, along the finger surface. Pratt's inserts are flexible to be tactiley responsive to the feel of coins in response to the force of the finger against the coins.

E. Examiner's limited statements above, do not provide a rationale or record based evidence sufficient to meet the examination standard of substantial evidence and cannot support a rejection under 35 USC 103. Examiner's rejection under 35 USC 103 should be vacated.

IX.

All Record Claims Should Be Allowed

Applicant has shown all of the record claims in this case are allowable.

Submitted,

  
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Application Number: 09/396,531  
Filing Date: 9/15/99  
Inventors: Randall Addington et al.  
Title: Method For Improving Bowler's Control

Group Art Unit: 3711  
Examiner Name: William Pierce  
Attorney Docket No.: 99-1001

Assistant Commissioner of Patents  
Washington, D.C. 20231

Amendment Appendix

Change the paragraph starting on page 18 and extending to page 19, to read as follows, (with changes shown)

The Bowler's Aid may include a stop means to limit the backward deflection of the Bowler's Aid, for example under the force of the bowling ball. The deflection stop means may be any suitable device, as would be apparent to one skilled in the art from the disclosure. For example, such a deflection stop means could be an overleaf {26} 24, as shown in Figure 8, attached or fastened to the at one end 27 to the support means 12a, 12b or held in place by the fastening means 18a, 18b, or attached to the Bowlers Aid at one end by any suitable means as would be apparent from one skilled in the art from the disclosure of the inventive principles. A free end 27, of the overleaf [26] 24 may extend over that part of the support means 12a, 12b, whose deflection is to be limited such as, for example, that part of the support means shown as between numerals 28 and 29 denoting the free part of overleaf [26] 24. A similar deflection stop, as would be apparent to one skilled in the art from the disclosure of the inventive principles, could be used to stop forward deflection of the bowler's finger toward the palm of the bowler's hand, for example, when fixed to that part 51, 52, 53, 55 of the Bowler's Aid and with its free end extending over support means 12a, 12b.